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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Santosh S. ARCOT

Application No.: 09/931,449 Art Unit: 1634

Filed: August 16, 2001 Examiner: Frank Wei Min Lu

For: MICROSPHERE BASED OLIGONUCLEOTIDE LIGATION ASSAYS, KITS, AND METHODS OF USE, INCLUDING HIGH-THROUGHPUT GENOTYPING

Attorney Docket No.: 215063.02901

REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT WITH PROVISIONAL ELECTION UNDER 37 C.F.R. § 1.143

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to Examiner's Restriction or Election Requirement (Paper No. 8), mailed July 22, 2002, and in accordance with the Rules of Practice, Applicant makes the following traversal of the restriction requirement with provisional election.

FORMALITIES

Please change the Attorney Docket No. to **"215063.02901"**.

PROVISIONAL ELECTION

Claims 1-36 were pending in the application. If election is not required following favorable consideration of the Traversal of the Restriction or Election below, then claims 1-36 will be pending and under active consideration. If election is required, however, then upon entry of the following election, claims 10-36 will be pending and under active consideration. Claims 1, 10, and 30 are independent.

Applicant provisionally elects claims 10-36, specified as Group II in paragraph 3 of the aforementioned Restriction or Election Requirement, as subject matter for examination in this case should the following arguments in favor of traversal of the restriction requirement be found unpersuasive. However, Applicant believes sincerely that restriction is not justified in this case, and Applicant urges respectfully that the restriction requirement be withdrawn, as noted below.

TRAVERSAL OF RESTRICTION REQUIREMENT

MPEP § 808.02 states that "[w]here, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper." The Restriction or Election Requirement, in paragraph 4, asserts that restriction is proper because Groups I and II, as defined in paragraph 3, are distinct inventions in that they are methods which comprise different method steps requiring different and distinct searches to be performed. Respectfully, Applicant traverses the restriction requirement on the basis that Groups I and II are related inventions and do not require different and distinct searches and, thus, examination of both groups will not be unduly burdensome.

MPEP § 808.02 requires that, for restriction to be proper for related inventions, the Examiner must show that the inventions have either: (A) separate classification; (B) a separate status in the art when they are classified together; or (C) different field of search. Inasmuch as the Restriction or Election Requirement notes with particularity that both inventive groups are classified in the same class and subclass: class 435, subclass 6, the inventions do not have separate classification. Applicant notes respectfully that the Restriction or Election Requirement does not assert that the inventions have a separate status in the art when they are classified together. It follows, therefore, that if Applicant shows that

examination of the claimed inventions does not necessitate a "search for one of the distinct subjects in places where no pertinent art to the other subject exists," then Applicant will have shown that restriction is improper because, where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." MPEP § 808.02 (C).

In paragraph 4, the Restriction or Election Requirement asserts that different and distinct searches will have to be performed; "[f]or example, the search required for Group II such as microspheres comprising a modifier moiety of claim 10 is not required for Group I." Applicant submits respectfully that this conclusion is mistaken because the assays of Group I are generic to the assays of Group II. Claim 1 (in Group I) recites spectrally-addressable bound probes, which are defined in the specification, at page 9, line 11, to page 10, line 3, as "a probe which is bound to a solid support, and in which the solid support is labeled for detection." In particular, page 10, lines 2-3, recite that a bound probe "is attached at one end to a spectrally addressable bead or microsphere, most typically coupled via a modifier moiety." Hence, Applicant submits respectfully that the microspheres and modifier moieties of Group II are implicit in Group I. Applicant submits respectfully, therefore, that any search performed for Group II will be pertinent to the subject matter of Group I and, as noted above, there is no reason for dividing among these related inventions.

CONCLUSION

Reconsideration and withdrawal of the restriction or election requirement and prompt examination subject application on its merits are respectfully requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by

telephone at (202) 625-3500. All correspondence should be directed to our address given below.

AUTHORIZATION

Applicant believes there is no fee due in connection with this filing. However, to the extent required, the Commissioner is hereby authorized to charge any fees due in connection with this filing to Deposit Account 50-1710 or credit any overpayment to same.

Respectfully submitted,

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Dated: August 22, 2002